



UNITED STATES PATENT AND TRADEMARK OFFICE

ST

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,657	02/20/2001	Ulf Landegren	LANDEGREN=1A	5356

1444 7590 06/30/2006

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT PAPER NUMBER

1637

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/785,657	Applicant(s) LANDEGREN ET AL.	
	Examiner Suryaprabha Chunduru	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7, 13-15 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7, 13-15, 17-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Upon considering the demonstration of common assignment of the instant application and the US patent 6,511,809, the suspension is terminated herein and the case is reopened for prosecution of the pending claims.

Status of the application

2. Claims 2-7, 13-15, 17-27 are pending. Claims 1, 8-12 and 16 are cancelled. Claims 14-15, and 25 are amended. All the arguments and amendment have been fully considered and found persuasive for the reasons that follow. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The information Disclosure Statement filed on March 28, 2005 has been entered and considered.

New issues

4. Claims 2-7, 20, 23-27 are directed to an invention not patentably distinct from claims 1, 7, 21, 22, and 26 of commonly assigned US patent 6,511,809.

Specifically, the instant independent claim 25 recites a method for detecting the presence of one or more analytes in solution, comprising (a) binding two or more proximity probes to a respective binding site on said one or more analytes not immobilized on a solid support, wherein each proximity probe comprises a binding

moiety with affinity for said one or more analytes and nucleic acids acting as a reactive functionality coupled to the binding moiety, (b) allowing the binding moiety to bind to the one or more analytes other than by Watson-Crick base pairing and allowing the nucleic acids of the proximity probes to interact with each other if the probes are in close proximity to each other, and (c) detecting the degree of interaction between the nucleic acids, thereby detecting the presence of one or more analytes in solution. Further the dependent claims 2-7, 20, 23-24, 26-27 further define the limitations in the independent claim 25. The instant claim 25 in combination with the dependent claims 2-7, 20, 23-24, 26-27 entirely encompasses the subject matter of the patented claims 1, 7, 21, 22, and 26.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned US patent 6, 511, 809, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the

invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments:

5. With regard to the rejection of claims 14-15 under 35 USC 112, second paragraph, Applicants' arguments and amendment are fully considered and found persuasive. The rejection is withdrawn herein in view of the amendment.

6. The Declaration submitted by the Applicants under CFR 1-132 has been fully considered.

7. With regard to the rejection of claims 2-7, 13-15, 17-27 under 35 USC 103(a) as being unpatentable over Landegren in view of Ebersole et al., Applicants' arguments, the declaration under CFR 1.132 and amendment have been fully considered and the rejection is withdrawn herein in view of the amendment and the declaration.


Conclusion

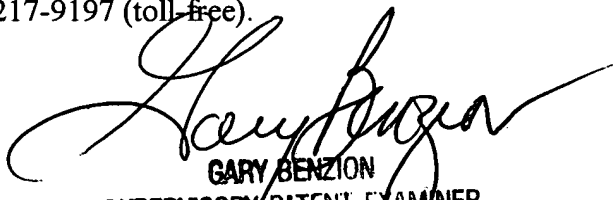
No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M , Mon - Friday,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Suryaprabha Chunduru
Patent Examiner
Art Unit 1637


GARY BENZION
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600